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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,691	04/17/2001	Donald Soares	52295/00101	7169
26116 7590 05/27/2004 SIDLEY AUSTIN BROWN & WOOD LLP 717 NORTH HARWOOD SUITE 3400 DALLAS, TX 75201			EXAMINER COSIMANO, EDWARD R	
			ART UNIT 3629	PAPER NUMBER

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/836,691

Applicant(s)

SOARES ET AL.

Examiner

Edward R. Cosimano

Art Unit

3629

MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-30 and 34-41 is/are allowed.
- 6) ☒ Claim(s) 31 and 32 is/are rejected.
- 7) ☒ Claim(s) 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/20/01 & 4/21/03.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. On 18 May 2004, the Examiner contacted Representative Nguyen in regard to a response to the Office Action mailed 13 February 2004 that the examiner could not locate in the instant file. Representative Nguyen responded that a response had in fact been filed on February 27, 2004 as indicated by the date of the Office's mail room stamp on a return postcard. The examiner then requested that Representative Nguyen fax a copy of the response and return post for review by the examiner.
3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).
4. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".
- 4.1 Claims 31 & 32 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.
- 4.1.1 Although the instant claims recite:
 - 1) a method, (claims 31 & 32), which has a practical application in the technological arts, and
 - 2) which do not define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon,

the instant claims merely define a series of steps to be performed on a computer.

4.1.2 In regard to claims 31 & 32, the invention as set forth in these claims merely describes:

A) a nonfunctional intended field of implementation/use, that is, "using a computer system", since the remainder of the claim does not require the steps to be performed using a computer.

B) an unaccomplished intended purpose/utility, that is, "for ensuring compliance with a pricing model", since although one of ordinary skill would recognize/understand that claim 31 does determine if an invoice complies with the pricing model, the claim fails to recite a limitation that one of ordinary skill would recognize/understand as ensuring that the invoice does comply with the pricing model, (it is noted that claim 33 corrects this particular defect).

C) a first step of estimating a first price of a print job based on a first set of specifications for the print job, modifying the first set of specifications for the print job into a second set of specifications for the print job and producing the print job based on the second set of specifications for the print job.

D) a second step of estimating a second price of a print job based on the second set of specifications for the print job.

E) comparing the second price for the print job to an invoice price for the print job to determine if the invoice price for the print job complies with the pricing model by determining if the invoice price for the print job is not substantially higher than said estimated second price for the print job.

F) claim 32 adds the concept of penalizing the printer if the invoice does not comply with the pricing model, however, the exact nature of the penalty is unknown and therefore is an abstract idea.

However, the process as recited in these claims does not apply the result of either the claim as a whole or the manipulations of data in such a manner so as to be tangibly used in a concrete manner and hence to produce a useful concrete and tangible result, that is a tangible application with in the technological/useful arts.

4.1.3 It is further noted that applicant has not recited in the claims a specific process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, which is either altered or changed or modified by the invention recited in claims.

4.1.4 It is further noted that applicant has not claimed either:

A) pre computer processing, since the claims fail to recited that the data, which originates from an unknown source, is manipulated or changed before it is processed, or

B) post computer processing, since the claims fail to recited that the data which represents the result of the claimed manipulation is either manipulated or used or changed by any device after it has been processed.

4.1.5 In view of the above, it is further noted that the invention of claims 31 & 32 lacks a claimed practical application since the claimed invention, either:

A) does not have the functionality required to carry out the recited steps or functions of the claimed invention; or

B) is not used by any system or device or method outside of the claimed invention,

in a concrete and tangible manner, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578; and State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)).

4.1.6 In view of the above, that is;

A) neither the results of the claim as a whole or the recited manipulations of data are used to produce a useful concrete and tangible result, that is a tangible application with in the technological/useful arts;

B) the claims as a whole fail to recite a specific machine/process that is either altered or changed or modified by the invention recited in claims;

C) the claims as a whole fail to recite any specific pre-solution or post-solution activities; and

D) the claims as a whole fail to recite any specific practical application of the invention as a whole or the manipulation of data;

Application/Control Number: 09/836,691

Art Unit: 3629

the invention of claims 31 & 32 is merely directed to an hypothetical mental exercise that manipulates an abstract idea.

4.1.7 It is further noted that the type/nature of either the data or the calculated numbers does not affect the operation of the claimed invention and hence are considered to be non function descriptive material, (note In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)).

4.1.8 In practical terms, claims define nonstatutory processes if they:

A) consist solely of mathematical operations without some claimed practical application (i.e., executing a "mathematical algorithm"); or

B) simply manipulate abstract ideas, e.g., a bid (Schrader, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759),

without some claimed practical application.

4.1.9 In view of the above analysis claims 31 & 32 as a whole are directed to an hypothetical mental exercise that merely manipulates an abstract idea, and hence are directed to non-statutory subject matter.

5. Claim 31 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5.1 Claim 31 is inoperative and therefore lack utility for the recited purpose of the disclosed and claimed invention, since:

A) intended purpose/utility of the invention as recited in claim 31, that is, "for ensuring compliance with a pricing model" is not accomplished by the claimed invention. The claimed invention does not accomplish it's purpose, since although one of ordinary skill would recognize/understand that claim 31 does determine if an invoice complies with the pricing model, the claim fails to recite a limitation that one of ordinary skill would recognize/understand as ensuring that the invoice does comply with the pricing model.

Art Unit: 3629

For as the Court has specifically pointed out, claims must recite utility for the disclosed purpose of the invention, (General Electric Co. V. U.S., 198 U.S.P.Q. 65 (U.S. Court of Claims, 1978), Hanson v. Alpine Valley Ski Area 204 U.S.P.Q. 794 (District Court, E. D. Michigan, N. Div. 1978) and Banning v. Southwestern Bell Telephone C., 182 U.S.P.Q. 683 (SD Tex, 1974)).

5.2 For the above reason, applicant has failed to particularly point out what is regarded as the invention.

6. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) the prior art, for example:

(1) Farrell (5,383,129), which discloses using a stored bill/charge/rate information and the specifications of a print job to estimated the cost of the printing job.

(2) Akita (JP 10-171875), which discloses using a stored bill/charge/rate information and the specifications of a manufacturing job to estimated the cost of the manufacturing job as well as the required raw materials.

(3) either Maruta (6,064,838) or Antoniak or Sevcik et al (6,330,542), which discloses using a stored bill/charge/rate information and the specifications of a print job to estimated the cost of the printing job, where the operator may change the specifications of the print job before the job is started.

(4) Watanabe (JP 2001-92616), which discloses using a stored bill/charge/rate information and the specification of a print job sent over a network to estimated the cost of the printing job.

(5) either Quallen et al (2002/0128953) or Soars et al (2002/0152183), which discloses using a stored bill/charge/rate information and the specifications of a print job to estimated the cost of the printing job, where the buyer and seller may negotiate the estimate.

B) however, in regard to claims 1, 21, 34 & 37, the prior art does not teach or suggest a printing estimating system in which a central location determines estimates for a number of print providers based on the specifications for a print job as received from

Application/Control Number: 09/836,691

Art Unit: 3629

an user, provides the user with at least the lowest cost estimate, and then permits the provider with the lowest cost estimated and the user to negotiation the actual cost of the print job. Claims 2-21, 22-30, 35, 36 & 38-41 are allowable for the same reason.

C) however, in regard to claim 31, the prior art does not teach or suggest a printing estimating system in which a print job is estimated based on the specifications for a print job received from an user, the specifications of the print job are modified and the print job is run using the modified job specifications, obtaining a second estimating the print job based on the modified specifications and then comparing the actual cost of the print job invoice and the second estimate to determine if the actual invoice complies with second estimate or substantially high than the second estimate. Claims 32 & 33 are allowable for the same reason.

7. Pursuant to applicant's request, attached are copies of the IDS statements filed July 20, 2001 and April 21, 2003.

8. Response to applicant's arguments.

8.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

9. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

Application/Control Number: 09/836,691

Art Unit: 3629


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

10.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

10.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

10.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

05/19/04


Edward R. Cosimano
Primary Examiner A.U. 3629